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REMARKS

In the amendments above, Claims 29, 71, 76, and 80 have been amended. The amendments are cosmetic and do not change the scope of the claims. Also, Claims 77 to 79, which were previously withdrawn from consideration by the Examiner, under protest from the Applicants, have been cancelled. Support for newly added Claims 83 and 84 can be found, for example, in Claims 29 to 45.

The specification has been objected to because it introduces new matter, namely, the non-tacky nature of the material. Similarly, Claims 29-45 and 66-76 have been rejected under the first paragraph of 35 U.S.C. §112 for not being based upon the disclosure, since they contain the non-tacky limitation.

Applicants respectfully submit that both the objection to the specification and the rejection of the claims under § 112 should be withdrawn. Applicants previously submitted a Second Declaration of Mark Aronhime, which declaration discussed the results of testing that confirms that the release layer that is part of Applicants' invention is not tacky. More particularly, Dr. Aronhime specifically reported experiments made to determine if, in the amounts of 10%, which is a limitation set forth in the specification, silicone oil renders the image transfer blanket of the invention tacky.

Attached hereto is a Third Declaration of Mark Aronhime. In this Third Declaration Dr. Aronhime provides additional details regarding testing performed, which testing confirms the non-tacky nature of the release layer of Applicants' invention.

Applicants submit that Dr. Aronhime's testing as set forth in his Second and Third Declarations is more than sufficient to support Applicants' position that the release layer

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of the image transfer member of the invention is not tacky.

Applicants wish to clarify a further point with regard to the types of silicone oil described as being used in the translated reference: The translated reference describes two types of silicone oil, and only one of these types is relevant to the tackiness property. Applicants submit that the Examiner has relied on the parts of the translation that refer to the type of silicone oil that is not at all relevant to the present invention as claimed. Thus, the entire thrust of the rejections based on both JP references is incorrect.

One type of silicone oil, having a viscosity of preferably 10,000 cps or less, and preferably less than the viscosity of the liquid raw rubber, is described as being an "adjusting agent to improve durability." At page 14 it is also described as improving mold release and cleaning. This agent has a maximum amount of 40%, and no minimum is given, since its use is apparently optional. It is not defined as having any effect on the tackiness of the layer. In the examples, 10% of a 30 cps oil is added. Applicants submit that this lower viscosity oil and references to it in the prior art reference have no bearing on tackiness.

A second type of oil, having a viscosity of 10,000 cps or more, and preferably higher than the viscosity of the base oil, is described as a tackifier. The silicone oil tackifier is not used in the examples.

A second point should be understood regard the reference. The reference teaches a combination of a "2-pack *addition type* cold-setting or thermosetting liquid raw silicone rubber" and a tackifier, which is selected from the group consisting of:

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- a) a 1- or 2- pack condensation type silicone varnish or its modification product;
- b) a 2-pack addition type cold setting or thermosetting liquid raw rubber;
- c) a solid raw methyl-, phenyl-, vinyl-, phenyl-vinyl, fluoro- or nitrile-silicone rubber; and
- d) a silicone oil with a viscosity of 10,000 cps or more.

These combinations are taken from the claim, which tracks the disclosure.

Thus, the translated reference has no teaching of any combination of a tackifying silicone oil with a *condensation* type silicone material, nor is there any teaching in the reference that silicone oil is a tackifying agent for *condensation* cured silicone rubber. Thus, the reference clearly does not anticipate the present claims.

Further, Applicants direct the Examiner's attention to page 15 of the translation where the amounts of tackifier and base oil are disclosed. Without specification of which tackifier is used, the limits on amount of tackifier are more than 2% and preferably more than 3% to 90%. Applicants presume that this broad range is meant to cover the ranges of all of the many types of tackifiers defined. In the Example, tackifier percentages of 30% are used. As indicated above, no example is given for silicone oil as a tackifier.

Claim 76 has been rejected under 35 U.S.C. §112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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Applicants regard as the invention. The Examiner's attention is directed to the amendments above, wherein Claim 76 has been amended to overcome the basis of the Examiner's rejection.

Claims 29-44, 66-74 and 76 have again been rejected under 35 U.S.C. §102(b) as being anticipated by Namiki, JP-57-19753 ("Namiki"). The Examiner maintains that Namiki discloses a transfer member comprising a substrate and a layer of silicone rubber (also called a tacky layer); that the layer of silicone rubber comprises a condensation-cured diorganopolysilozane; and that a diorganopolysilozane is the *identical* condensation cured silicone used by Applicants, as disclosed on page 22 of the specification.

Applicants respectfully traverse this rejection.

The Namiki reference does not provide a *prima facie* case of anticipation. As set forth in the Amendment dated December 26, 2002, and as discussed above, the declarations of Dr. Aronhime and the discussion of this reference and its "twin" the '742 reference made above, make the arguments advanced by the Examiner moot. First, there is no teaching in Namiki of any mixture of a condensation cured silicone material with any *tackifying* silicone oil. Dr. Aronheim's declarations prove that, at least for the preferred *tackifying* silicone oil of the reference with condensation cured silicone (a combination not even mentioned in the reference), the resulting material is not tacky. Furthermore, Dr. Aronhime's declarations show that the combinations actually taught in the present application are not tacky. Finally, it is clear that the portions of the reference relied on by the Examiner actually refer to a silicone oil that is not a tackifier.

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Further, it is noted that oxides of metals are not generally conductive.

Claims 29, 39-41 and 76 remain rejected under 35 U.S.C. §102(b) as being clearly anticipated by Ryoichi, JP 57-020742 ("Ryoichi"). The Examiner acknowledges Applicants' confusion regarding the application of this reference. However, the Examiner maintains that the abstract clearly discloses a medium comprising transfer layer comprising a condensation-cured silicone and that application of this reference is appropriate.

Applicants still do not understand why this reference, for which only an abstract is available, was presented. For the purpose of discussion, Applicants assume that the relevant portions of the reference relate to an apparatus (use) version of the Japanese reference for which a translation was provided. Applicants note that the new reference is dated only four days after the previously cited reference and is assigned to the same assignee. Furthermore, the wording used in the abstract of the newly provided reference is substantially identical to wording used in the translated reference.

Applicants submit that Ryoichi does not provide a *prima facie* case of anticipation. As discussed above, this reference simply does not disclose Applicants' invention. In addition, any burden on the Applicants to prove that the disclosed release layer is non-tacky, has been met by at least the Second Declaration of Dr. Aronhime.

Furthermore, the declarations by Dr. Aronhime point out that the viscosity of the silicone base oil used depends primarily on the amount of filler used. As is clear from the specification sheet attached to the Second Declaration, the viscosity of the base oil including the filler material is in the range of 10,000+ cps. Moreover, it is clear from Dr. Aronhime's declarations that if substantial amounts of filler material are removed from

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the commercial silicone precursors that he used, the viscosity is 1,000 to 4,000 cps.

The Examiner is referred to page 14 of the translation for a definition of the tackifying silicone oil, which is defined with relation to the viscosity of the silicone base material. According to this definition 10,000 cps is the range of viscosity of the silicone base materials used and, thus, these materials contain the normal amount of filler materials, on the order of 20%.

Claims 29-33, 35-41 and 76 remain rejected under 35 U.S.C. §102(b) as being anticipated by Wang, Jr., U.S. Patent No. 5,114,520 ("Wang"). The Examiner maintains that Wang comprises Applicants' identical components present in identical amounts; that consequently, it is inherent the medium functions in the manner claimed by Applicants: that Applicants, while referring to a special construction of a transferring member, do not claim a particular structure: and that the claims at issue are to a substrate with a layer comprising a condensation-cured silicone thereon and Wang discloses just such an article.

Applicants respectfully traverse this rejection.

Wang does not provide a *prima facie* case of anticipation. Wang describes a system in which an image is formed on directly on a paper carrier layer, which image is then transferred to a vinyl sheet. The image in Wang is *developed* directly onto the paper carrier sheet of Wang. This does not meet the requirement of the claims herein that transfer member be suitable for the transfer of toner images *received* from a first surface and *transferring* them to a second surface. There is no teaching in Wang of how such the paper substrate could be used as an intermediate transfer member. An intermediate transfer member suitable for both receiving and transferring images must have a special

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construction to operate well, as taught in the instant specification. The simple paper substrate system of Wang is not commensurate with the image transfer member that is the subject of Applicants' invention.

In addition, as is quite clear from the text in Wang, the condensation that is described is not used for forming the polymer. Rather, it is used to attach a minor amount of the silicone to a monomer. The actual curing of the material, which is not *per se* "a silicone material", is through polymerization of the monomers and is not connected with the silicone at all. Furthermore, Wang just does not teach any intermediate transfer member at all, which is enough to destroy any *prima facie* anticipation as alleged by the Examiner.

Clearly Claims 29-45 are not disclosed, or even suggested, by Wang. Therefore, the rejection based on Wang should be withdrawn.

Claims 80-82 have been rejected under 35 U.S.C. §102(b) as being anticipated by Namiki. The Examiner contends that Namiki discloses a transfer member comprising a substrate and a layer of silicone rubber; that the layer of silicone rubber is equivalent to Applicants' release coating- it comprises a condensation-cured silicone; that the layer of silicone rubber further comprises a cross-linking agent and, *optionally*, fillers; that the layer does not require that fillers be present in the medium; that the layer of silicone rubber, moreover, possesses a thickness value within the value claimed by Applicants (5  $\mu\text{m}$  or more); and that the Namiki article is a transfer blanket - an image is placed on the tacky layer (i.e., from a first surface), and then transferred to another surface (i.e., a second surface); in addition, "it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not

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cause a claim drawn to those things to distinguish over the prior art," citing *In re Swinehart et al.*, 169 USPQ 226 at 229. The Examiner also contends that since Namiki teaches all of Applicants' claimed compositional and positional limitations, it is inherent that the transfer member functions in the manner claimed by Applicants, that is, since the member comprises all of Applicants' claimed components in the same amounts as claimed by Applicants (e.g., a layer comprising condensation cured silicone and no filler material), it is inherent that the transfer member functions in the manner claimed by Applicants, i.e., that it possesses the ability to receive and image from a first surface and transfer the image to a second surface; that the burden is upon the "applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon..." and that, to date, this burden has not been sustained.

Applicants respectfully traverse the above rejection.

Applicants submit that Claim 80 and the claims dependent thereon are not *prima facie* anticipated by the art cited by the art cited by the Examiner.

As indicated above, with respect to the rejection of Claims 29, 39-44 and 76, the declarations by Dr. Aronhime point out that the viscosity of the silicone base oil used depends primarily on the amount of filler used. As is clear from the specification sheet attached to the Second Declaration, the viscosity of the base oil including the filler material is in the range of 10,000+ cps. Moreover, it is clear from Dr. Aronhime's declarations that if substantial amounts of filler material are removed from the commercial silicone precursors that he used, the viscosity is 1,000 to 4,000 cps.

The Examiner is again referred to page 14 of the translation for a definition of the tackifying silicone oil, which is defined with respect to the viscosity of the base material



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used. According to this definition 10,000 cps is the range of viscosity of the silicone base materials used, and, therefore, these materials contain the normal amount of filler materials, on the order of 20%.

Thus, there is clearly no teaching of using a similar material without fillers in any of the art cited by the Examiner, despite the advantages discovered by the inventors (as set forth in Dr. Aronheime's declarations) for removing the filler material.

Applicants respectfully submit that none of the claims is anticipated by or rendered obvious over the references of record. Applicants believe that the present application is in condition for allowance. Accordingly, favorable consideration and allowance of this application are requested.

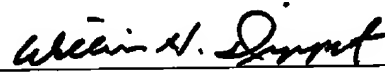
Applicants respectfully submit that the instant paper should be considered and then entered in the record. The amendments above and the attached declaration are directly responsive to issues raised for the first time by the Examiner in the latest Office Action. Moreover, these amendments and declaration are intended to either put the claims in allowable condition or simplify issues for appeal, and are not intended to raise new issues that would require further searching by the Examiner.

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Should the claims herein be allowable but for minor matters that could be the subject of an Examiner's Amendment or supplemental paper by Applicants, Applicants would appreciate the Examiner's contacting Applicants' undersigned attorney.

Respectfully submitted,



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